

REMARKS

This application has been carefully reviewed in light of the Office Actions mailed December 31, 2003 and January 30, 2004. Claims 1-37 are pending in the Application. Claims 1, 3, 5-6, 8, 11, 13-14, 16-20, 23, 25 and 29 have been amended. Applicant respectfully requests reconsideration and favorable action of all pending claims in view of the following remarks.

Specification

The Office Action indicated the word "Amplenol" is a trademark. Applicant has capitalized "Amplenol" in the specification and removed it from the claims. Favorable action is requested.

Section 112 Rejections

The Office Action asserts numerous Section 112 paragraph 2 rejections against the claims. Although Applicant traverses, in order to expedite prosecution, the claims have been amended to address these rejections. Favorable action is requested.

Nevertheless, Applicant does address the impropriety of the rejections based on the grounds that "it is unclear because it is not clear what step limitation is intended by the recitation." The Office Action provides no authority suggesting that every recitation in a method claim recite what the Examiner refers to as "a step limitation" to comply with Section 112, paragraph 2. From these 112 rejections, Applicant surmises that the author of the Office Action contends that every grammatical phrase in a claim that recites "a method" in the preamble must begin with a verb, but there is no authority to this effect. Nevertheless, Applicant has amended the claims rejected on these grounds in a manner believed to be unobjectionable to the Examiner, solely to expedite prosecution. In doing so, Applicant has not narrowed the scope of the claims and does not intend to surrender any subject matter.

Section 101 Rejections

Applicant respectfully traverses the rejection of particular claims based on 35 U.S.C. Section 101. In support of the rejection, the Office Action cites *Ex parte Lyell*, 17 USPQ 2d 1548. That case does not support rejection of the claims. It involved a claim with a preamble that recited "an automatic transmission tool and method for using same

comprising," which was not the case with the rejected claims, which recited only "a method." The case does not stand for the proposition that every phrase in a method claim must begin with a verb. A copy of this case relied on by the author of the Office Action is enclosed for convenience. Nevertheless, Applicant respectfully submits that the presently amended claims would also not be objectionable because of the amendments made to address the Section 112 rejections described above. Favorable action is requested.

Section 102 and 103 Rejections

As an initial matter, Applicant notes that U.S. Pub. No. 2002/0179720 (hereinafter "the '720 Publication"), has an actual filing date after the filing date of the present application and therefore cannot be used to reject the claims under 102(e) or 102(e)/103 unless there is "proper support for the subject matter as required by 35 U.S.C. 119(e) or 120," (see M.P.E.P. § 706.02, Example 2, for example,) in a priority document with a filing date earlier than the present application (and subject to any possible swear behind). In the present case, the provisional application relied upon for priority was not even included in the initial Office Action, nor was any indication given in the Office Action of what elements in the provisional application were intended to provide "proper support for the subject matter" in the '720 Publication used in rejecting the claims. Rather, Applicant's representative obtained a copy of the provisional application by requesting one from the Examiner. Thus, it appears that no determination was made by the PTO of what the provisional application did or did not disclose.

The provisional application discloses neither the material relied on in rejecting the claims, nor each and every limitation of the claims, and for this reason alone, the rejections of the claims based on the '720 Publication are improper. In particular, the Office Action relies on the embodiments of Figures 4 and 5 of the '720 Publication, yet neither these figures nor any equivalent figures or designs are provided in the provisional application. Thus, the Office Action rejects the claims based solely on material filed in the PTO after the filing date of Applicant's application, which is improper. Reconsideration and favorable action is requested.

Even if the provisional application did provide support for the portions of the '720 Publication used in the rejections (which it does not) the rejections would nevertheless be improper because that publication does not teach each and every limitation of the claims. For example, Claim 1, as amended (to address the 112 rejections), recites "coupling the input

node of the first card to the input node of the second card to provide redundancy for the first card by connecting the input node of the first card to the associated output node of the first card." The '720 Publication does not show this limitation, nor does the Office Action assert it does. In rejecting Claim 1, the Office Action asserts the '720 Publication shows "connecting the input node of the first card, thereby coupling the input node of the first card to the input node of the second card to provide redundancy." Notably, this recitation in the Office Action omits the actual claim language of that claim, which recites "**connecting the input node of the first card to the associated output node of the first card.**" Thus the Office Action essentially concedes that the '720 Publication does not show connecting the input node at the first card to an output node of the first card.

The reference does not show this limitation. Rather, the systems of Figures 4 and 5, on which the Office Action relies, involve decoupling input and output nodes of line cards from respective connections and coupling of these nodes to other connections – but not to each other. In rejecting Claim 1, the Office Action relies on paragraph 0023 of the '720 Publication to show "connecting the input node of the first card, thereby coupling the input node of the first card to the input node of the second card to provide redundancy," Office Action Pages 5-6 – while not asserting that the above described "connecting the input node of the first card to the associated output node of the first card" limitation is met. But paragraph 0023 of that reference makes no disclosure of "connecting the input node of the first card to the associated output node of the first card." For at least this reason Claim 1 is allowable, as are the claims depending therefrom. Reconsideration and favorable action are requested.

Independent Claim 14 is allowable for analogous reasons, as are the claims depending therefrom. Reconsideration and favorable action are requested.

Independent Claim 26 is allowable for analogous reasons. In particular, the '720 Publication does not show "a switch [on the first and second cards] operable to selectively connect the input node of the card to either the output node of the card or the card logic." The Office Action does assert that this limitation is met, pointing to Figure 5 in general with no identification of what element or elements shown in that figure show such a switch – perhaps no identification is made because Figure 5 does not show such a switch. As described above, the system of Figure 5 involves decoupling the input and output nodes of line cards from respective connections and coupling these nodes to other connections – but not to each other. For at least this reason Claim 26 is allowable, as are the claims depending therefrom. Reconsideration and favorable action are requested.

CONCLUSION

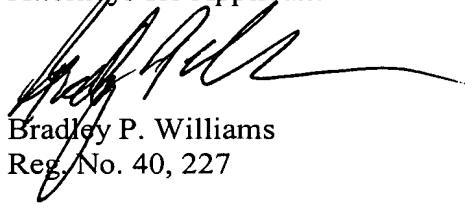
Applicant has now made an earnest attempt to place this case in condition for immediate allowance. For the foregoing reasons and for other apparent reasons, Applicant respectfully requests allowance of all pending claims.

If the Examiner feels that prosecution of the present Application may be advanced in any way by a telephone conference, the Examiner is invited to contact the undersigned attorney at 214-953-6447.

Applicant does not believe that any fees are due. However, the Commissioner is hereby authorized to charge these fees and any extra fee or credit any overpayments to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,

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